

REMARKS

In the Office Action mailed February 15, 2005, the Examiner rejected claims 21-40. By way of the foregoing amendments and the markings to show changes, Applicants have amended claim 1. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Amendments

Applicants have amended claim 1 to remove the term "zig zag configuration". Applicants suggest that the Examiner for the present application may be defining the term zig zag more narrowly than was intended by Applicants. As suggested in the previous Office Action response, the term zig-zag configuration, as used in the present application, merely means a pattern created by traveling along a path in a side-to-side manner, unless otherwise specifically stated.

II. Claim Rejections under 35 USC 103

The Office Action rejected claims 21-40 as being obvious in view of various combinations of the following references: Noda et al. (4631976); Steuart et al. (1581884); Rico (4981737); Kurata et al. (4547655); Bonn et al. (6441344); Okabe (JP2001020044); Sugiyama et al. (6414270); Haushultz et al. (5714738); Haag (6093908). Applicants traverse these rejections on several grounds as discussed below.

As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Court of Appeals for the Federal Circuit, in the case of In re Lee, 61 USPQ2d 1430 (CAFC 2002), wrote:

The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.");...

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 21

The Office Action rejected claims 21-23 as being unpatentable over Noda et al. in view of Steuart et al and further in view of Rico. Applicants traverse these rejections one at least two grounds. First, the Office Action has not properly shown that particular language of claim 21 is contained in the prior art. Second, the rejections are based upon an improper combination of references.

The Office Action has not properly shown that particular language of claim 21 is contained in the prior art.

The Office Action reads that, "... Rico discloses a tool wrap having a cushion-polyurethane layer 12 that can elongate up to 500%." The Office Action reads further that, "It would have been obvious to ... modify Noda's invention to include ... a cushion as taught by Rico in order to permit elongation of the cushion and the separator at least 50%..." It appears from these statements that the material of Rico is only being suggested, by the Office Action, for the material of the cushion of claim 21. As such, the Office Action has ignored the language of claim 21 reading that the separator is, "formed of a material that has an elongation characteristic permitting it to be elongated at least about 50% of its own length prior to failure". As such, the Office Action ignored language of claim 21 thereby failing to assert a prima facie case of obviousness against claim 21.

The rejections of claims 21-23 are based upon an improper combination of references.

The combination of Rico with Noda is improper for at least three reasons. First, the Office Action provides no motivation for combining Rico with Noda. Second, there is no likelihood of success for the combination of Rico with Noda. Third, the Rico is from a non-analogous art.

The Office action suggests that it, "would have been obvious ... to modify Noda's invention to include a heating element as taught by Steuart and a cushion as taught by Rico in order to permit elongation of the cushion and the separator at least 50%, wherein the heater can also elongate about 15% of its own length since the heater of Noda in view of Steuart utilizes the same zig-zag configuration and the cushion utilizes a polyurethane, as in applicant's invention." This statement, however, provides no motivation and, even more to the point, no specific motivation for combining Rico with Steuart. Thus, the Office Action fails to assert a prima facie case of obviousness against claims 21-23 of the present application.

Even if some motivation were provided by the prior art, it is unlikely that the skilled artisan would have combined Rico with Noda since the combination provides no likelihood of success. In particular, the Office Action identifies "covering 5" of Noda as a cushion layer and then suggests that "absorbing layer 16" of Rico could be substituted for that covering. However, the "covering 5" of Noda is a main body

portion of a steering wheel while the "layer 16" of Rico is a thin layer of a tool handle as particularly indicated at column 2, lines 34-40 of Rico. As such, the skilled artisan would be very unlikely to substitute the "layer 16" of Rico for the "covering 5" of Noda as the "layer 16" would likely be insufficiently thick for operating as the "covering 5" of Noda and further would likely be undesirably elastic as the "covering 5" of Noda. As such, the skilled artisan would be unlikely to be successful in combining Rico with Noda and therefore unlikely to make such a combination. Thus, the combination of Rico with Noda represents a combination based upon impermissible hindsight since no specific motivation is provided for the combination and the actual combination is quite unlikely to be made by the skilled artisan.

In addition to the above, the combination of Rico with Noda is improper because Rico and Noda are from non-analogous arts. Rico has nothing to do with the heating of any handle. As such, the skilled artisan would be unlikely to look to Rico for a layer to use in Noda.

Claim 25

Applicants traverse the rejection of claim 25 on the ground that the Office Action fails to assert a Prima Facie case of obviousness against claim 25. In particular, the Office Action cites a 0.5% range of Nickel in Okabe as rendering the "about 1 % and about 10 % nickel" of claim 25 obvious. However, the value cited by the Office Action is not even within Applicants' range. As such, the Office Action fails to assert a prima facie case of obviousness against claim 25. Applicants also traverse the rejection of claim 25 on the ground that Okabe is improperly combined with the other references of record to arrive at an unwarranted obviousness rejection. In particular, Applicants find no indication or motivation in the prior art or from the Office Action as to why the wire of Okabe would be suitable to substitute into a heater of a heated handle. Again, the Office Action fails to assert a prima facie case of obviousness against claim 25.

Claims 26-28

Applicants traverse the rejections of claim 26-28 because the Office Action cites references having values that are outside of the ranges claimed by Applicants and has therefore failed to assert a prima facie case against those claims.

Claims 29-30

Applicants traverse the rejection of claims 29-30 because the Office Action incorrectly cites Haag as disclosing, at Col. 4, Lines 40-50, "the cushion ... laminated to the separator with an adhesive" and the adhesive ... provided as a monolayer adhesive film" as recited in claims 29-30. However, Applicants review of Col. 4, Lines 40-50 of Haag has found no indication that Haag discloses that which is recited in the aforementioned language. As such, Applicants assert that the Office Action fails to assert a prima facie case of obviousness against claims 29-30.

Claims 31-40

Applicants traverse the rejections of claims 31-40 for all the same reasons as indicated above where such reasons apply. Applicant further traverse the rejections of claims 31-40 for additional reasons below.

Claims 31 and 37

Applicants additionally traverse claims 31 and 37 on the grounds that the Office Action ignored language of claims 31 and 37 thereby failing to establish a prima facie case of obviousness against those claims. In particular, both claim 31 and claim 37 substantially recite a core of a steering wheel that include a core that is formed of, "a rigid member that is at least partially covered with a polymeric material, the core having a substantially circular configuration". Applicants find no mention of this language by the Office Action. Further, Applicants contend that recognition of this language by the Office Action would force reconsideration of the manner in which components were identified in Noda for the rejection of claim 21. Without consideration of this language, the Office Action has failed to establish a prima facie case of obviousness against claims 31 and 37 and their dependents.

For all the reasons above, Applicants request that the obviousness rejections of claim 21-40 be withdrawn.

Moreover, Applicant points out that it would likely be improper to present a final rejection of claims 21-40 on a grounds alternative to that already presented since applicants have not amended claims 21-40 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

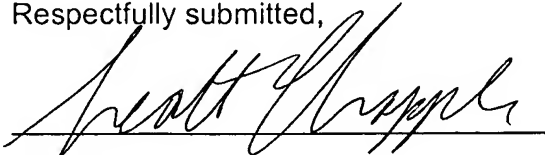
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Dated: 19 April, 2005

Respectfully submitted,



Scott Chapple
Registration No. 46,287
DOBRUSIN & THENNISCH PC
29 W. Lawrence Street
Suite 210
Pontiac, MI 48342
(248) 292-2920

Customer No. 25215